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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,397	04/11/2000	Hiroshi Satomi	862.C1898	4943

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EXAMINER

LIANG, GWEN

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/547,397	SATOMI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	GWEN LIANG	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 55-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>                    </u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications through the applicant's amendment, and Request for Continued Examination (RCE) filed on 4/25/2006.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 55-62 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 55, the claimed subject matter, a computer system, does not contain a computer component (hardware). All the means plus functions as claimed are software per se. Without functional relationship between the claimed functions and any computer component, the system as claimed is not capable of producing tangible results and therefore not statutory.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 55, 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al., "Morimoto" (European Patent No. 343918), in view of Johari et al., "Johari" (U.S. Patent No. 5,911,146).

With respect to claim 55, Morimoto discloses a method ... comprising:

first registration means for registering first information associated with a unique identification code (col. 5, lines 4-5, "the user inputs the keyword A to obtain the phone number of Mr. A", wherein the keyword "A" inputted by the user is an identifying keyword used to identify information on Mr. A, and therefore is equivalent to a unique identification code; Figure 3a, Data "a", wherein the "A" is an identification code used to identify the information of Mr. A);

keyword list generation means for generating a first keyword list of the registered first information (Figure 3a, Data "a", wherein "A, X" is considered to be the first keyword list of the registered first information, "MR A WORKS FOR THE COMPANY X"; col. 4, lines 6-9, "The input unit 11 inputs data and keywords associated therewith. Further, the unit 11 inputs commands for designating keywords of data to be retrieved, and for executing such retrieval"; col. 4, lines 13-19, "The registration of keywords is performed as follows. Specifically, the particular words to be registered as keywords are selected from the words that constitute the input data. Such word selection is achieved by moving a contrasting display to the particular words by use of the keyword-locating keyswitch. Thereafter, the keyword-registering keyswitch is depressed");

second registration means for registering second information associated with a second keyword list (Figure 3a, wherein "X" is considered to be the second keyword list

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of the registered second information, "PHONE NUMBER OF THE COMPANY X IS MMM-NNNN"; col. 4, lines 9-12, "The data-storing unit 14 is a data base that stores the data input by means of the input unit 11. The unit 14 stores such data on the basis of keywords");

accepting means for accepting input of the unique identification code; acquisition means for acquiring the first information associated with the input identification code (col. 5, lines 4-5, "the user inputs the keyword A to obtain the phone number of Mr. A", wherein the keyword "A" inputted by the user is an identifying keyword used to identify information on Mr. A, and therefore is equivalent to a unique identification code; col. 5, lines 7-45, "... First, the keyword "A" is input ... Next, the data retrieval-controlling unit 15 retrieves the datum "a" of FIGURE 3a having the keyword "A" which has been stored in the keyword memory ... Thereafter, keywords associated with the datum "a" are extracted by the keyword-extracting unit ...");

search means for searching the second information based on the first keyword list of the acquired first information and the second keyword list (col. 5, lines 42-50, "In this case, the keyword X is included as the keyword of the datum "a" besides the keyword "A". Thus, the keywords "A" and "X" are stored in the keyword memory 18 (Step 7). The operations of Step 4 through Step 7 are continuously performed until all the data having the keyword "X" are extracted (Step 8). After the continuous retrieval of the keyword "X" in Step 8, the datum "b" of FIGURE 3a can be extracted"; col. 6, lines 1-3, "Next, the apparatus retrieves data on the basis of the keyword "X", and obtains the datum "b"; col. 6, lines 20-25, "... the retrieval operations of relational data are

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performed twice. Specifically, the second retrieval is performed on the basis of the keyword "X" of the second keyword list, which was obtained from the first keyword list, "A, X" of the acquired first information "MR A WORKS FOR THE COMPANY X". Therefore the final retrieval of the second information is based on both the first keyword list and the second keyword list in this embodiment);

However Morimoto does not explicitly disclose print layout generation means for generating a print layout for laying out a content of the acquired first information into a sheet together with the searched second information.

Johari discloses print layout generation means for generating a print layout for laying out a content of the acquired first information into a sheet together with the searched second information (Abstract, "a computer-based system for automatic pagination and layout of yellow pages ... uses a simulated annealing heuristic to refine a randomly determined candidate solution. The text and advertisements which are to be included in the yellow pages directory are ordered in two distinct data streams representing the order of text and the order of advertisements ...; The system determines a possible layout ... The solution is scored ... The revised solution is then kept according to a probabilistic formula relating the two scores ... Through an iterative process of perturbations, scoring, and comparing, the candidate solution becomes optimized. The process is repeated multiple times for different initial candidate solutions, ... A best solution is then selected from all of the optimized candidate solutions", wherein a computer- based system taught in Johari for automatic pagination and layout of yellow pages is inherently capable of "generating a print layout for laying

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out a content of the acquired first information into a sheet together with the searched second information “ as claimed in the applicant's invention).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate print layout generation means as disclosed by Johari into the information providing system as disclosed by Morimoto for providing a computer system for automatically paginating and laying out yellow page advertisements and text (col. 1 lines 10-14). ). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

Claim 61 is rejected for the reasons set forth hereinabove for claim 55 and furthermore the combination of Morimoto and Johari discloses a system wherein said keyword list generation means generates the first keyword list of the first information based on a property of the first information, a property of a user (Morimoto, Figure 3a, Data “a”; col. 4, lines 6-9) and a property of a print terminal (Johari , Abstract);

Claim 62 is rejected for the reasons set forth hereinabove for claim 55 and furthermore the combination of Morimoto and Johari discloses a system wherein said search means searches a plurality of the second information (col. 5, lines 42-50; col. 6, lines 1-3; col. 6, lines 20-25); and wherein said print layout generation means generates a plurality of print layouts in correspondence with each of the plurality of the searched second information (Abstract);

Claims 63 and 64 are similarly rejected on grounds corresponding to the reasons given above for claim 55.

5. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al., "Morimoto" (European Patent No. 343918), in view of Johari et al., "Johari" (U.S. Patent No. 5,911,146), further in view of Morita (U.S. Patent No. 5,297,042), and further in view of Rapaport et al., "Rapaport" (U.S. Patent No. 5,890,152).

Claim 56 is rejected on grounds corresponding to the reasons given above for claim 55.

However the combination of Morimoto and Johari does not explicitly disclose a system wherein the first and second keyword lists have a weight value for each keyword within the first and second keyword lists, the weight values corresponding to positive or negative contents of the first and second information, and wherein said search means searches the second information based on the weight values of the keywords.

Morita discloses a system wherein the keyword lists have a weight value for each keyword within the keyword lists (Abstract, "A document retrieval system includes an inputting unit for inputting a retrieval condition including one or a plurality of keywords and a weight value for each keyword..."; col. 1 lines 36-39, "...a large number of fields [candidate information], each corresponding to one or more keywords, must be determined to correctly retrieve documents which are required by the user."; col. 4 lines 10-12, "The weight data ... corresponding to the keywords K are supplied from the input analysis unit 1 ..."), and wherein said search means searches the second information



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based on the weight values of the keywords (col. 2 lines 58-65, "The associative retrieval unit 2 calculates a relevance value of each document on the basis of the weight data  $Q_k$ , the relationship values and the importance values in accordance with predetermined equations. The relevance value of each document represents the degree of relevance in satisfying the user's requirement. The associative retrieval unit 2 supplies the relevance value of each document to the output controller 3."; col. 4 lines 14-36, "The weight data  $Q_k$  ... is multiplied by the link factor  $W_{kj}$  in the keyword connection link 9. ... In the  $j$ -th unit in the hidden layer 6, an addition for generating the sum of the  $n$  products  $Q_k * W_{kj}$  ( $k=1, 2, \dots, n$ ) which are supplied from  $n$  units in the input layer 5 via the keyword connection link 9 and a threshold processing are performed. ... In the  $i$ -th unit in the output layer 7, an addition for generating the sum of the  $n$  products  $K_j * S_{ji}$  ( $j=1, 2, \dots, n$ ) which are supplied from  $n$  units in the hidden layer 6 via the keyword-document connection link 10 ... are performed. Then the result  $D_i$  is obtained as the relevance value. That is, each unit in the output layer 7 outputs the relevance value  $D_i$  as the retrieval result.").

It would have been obvious to one having ordinary skill in the art at the time the invention was made to assign weights as disclosed by Morita to the keyword lists as disclosed in the combination of Morimoto and Johari to provide a document retrieval system which can be constructed with ease (col. 1 lines 50-52). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

However the combination of Morimoto, Johari, and Morita does not explicitly disclose a system wherein the weight values corresponding to positive or negative contents of the information.

Rapaport discloses a system wherein the weight values corresponding to positive or negative contents of the information (col. 6 lines 27-37, "Typically there are many key words and key phrases with corresponding signed weights contained in a particular Profile Object. The bundle of key words and key phrases may include positive weighted key words/key phrases, typically for synonyms. Negative weighted key words/key phrases, typically for antonyms, identify a particular identity, trait, interest or descriptive term that the Profile Object represents. These key words and key phrases have corresponding numerical values which are used to rate retrieved media files in terms of the user's interest.").

It would have been obvious to one having ordinary skill in the art at the time the invention was made to assign weight values to keywords as disclosed in the combination of Morimoto, Johari, and Morita, based on positive or negative contents of the information as taught in Rapaport, thus the keyword values are used to rate retrieved media files in terms of the user's interest (See for example; col. 6 lines 34-37).

6. Claims 57, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al., "Morimoto" (European Patent No. 343918), in view of Johari et al., "Johari" (U.S. Patent No. 5,911,146), and further in view of McCollom et al., "McCollom" (U.S. Patent No. 6,343,274).

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Claim 57 is rejected on grounds corresponding to the reasons given above for claim 55.

However the combination of Morimoto and Johari does not explicitly disclose a system wherein said search means further searches the second information based on due data of insertion of the second information.

McCollom discloses a system wherein said search means further searches the second information based on due data of insertion of the second information (col. 6, lines 28-35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate searching information based on due date of insertion of the information as disclosed by McCollom into the information providing system as disclosed in the combination of Morimoto and Johari for the advertisement to be published properly (col. 6, lines 28-35). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

Claim 60 is rejected on grounds corresponding to the reasons given above for claim 55.

However the combination of Morimoto and Johari does not explicitly disclose a system wherein said search means further searches the second information based on an insertion frequency of the second information.

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McCollom discloses a system wherein said search means further searches the second information based on an insertion frequency of the second information (Figure 11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate searching information based on an insertion frequency of the information as disclosed by McCollom into the information providing system as disclosed in the combination of Morimoto and Johari for providing the ability to publish advertisements, get reports based upon the statistics collected from the consumer user interface program (col. 2, lines 62-67). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

7. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al., "Morimoto" (European Patent No. 343918), in view of Johari et al., "Johari" (U.S. Patent No. 5,911,146), and further in view of Ohtani et al., "Ohtani" (U.S. Patent No. 6,212,545).

Claim 58 is rejected on grounds corresponding to the reasons given above for claim 55.

However the combination of Morimoto and Johari does not explicitly disclose a system wherein said search means further searches the second information based on a charge amount of the second information.

Ohtani discloses a system wherein said search means further searches the second information based on a charge amount of the second information (Abstract,

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"The cost information may be included in a search request of an information resource searcher making a search request to search the stored advertisement information").

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate searching information based on a charge amount of the information as disclosed by Ohtani into the information providing system as disclosed in the combination of Morimoto and Johari for selecting the best information resource being the best through simultaneous advertisement of information resource using automated management of information regarding information resources, and returning the search result to a user via the advertisement of information resource by the information resource provider and inquiry from a user (col. 4, lines 22-28). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

8. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al., "Morimoto" (European Patent No. 343918), in view of Johari et al., "Johari" (U.S. Patent No. 5,911,146), and further in view of Gudmundson et al., "Gudmundson" (U.S. Patent No. 5,032,707).

Claim 59 is rejected on grounds corresponding to the reasons given above for claim 55.

However the combination of Morimoto and Johari does not explicitly disclose a system wherein said search means further searches the second information based on a print limitation of the second information.

Gudmundson discloses a system wherein said search means further searches the second information based on a print limitation of the second information (col. 4, line 64 – col. 5, line 21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate search means for searching information based on a print limitation of the information as disclosed by Gudmundson into the information providing system as disclosed in the combination of Morimoto and Johari for producing a customer receipt containing dealer location, order number, product description and code, and other possible marketing information (col. 5, lines 1-4). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

***Response to Arguments***

9. Applicant's arguments with respect to all the pending claims have been considered but are moot in view of the aforementioned new and/or additional ground(s) of rejection based on the previously relied prior art.

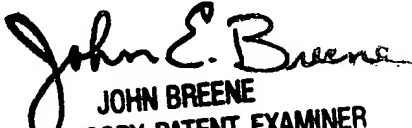
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GWEN LIANG whose telephone number is 571-272-4038. The examiner can normally be reached on 9:30 A.M. - 5:30 P.M. Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20 June 2006  
G.L.

  
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